

REMARKS

The present amendment is in response to the Office Action dated September 12, 2011, which set a three-month period for response, making this amendment due by December 12, 2011.

Claims 1, 2, 4-8, 10-12, 14-15, 17-22, and 24-26 are pending in this application.

In the Office Action, the prior indicated allowance of the claims was withdrawn in view of the newly discovered reference to Wu, PG Pub. No. 2005/0252707. As a result, the previously imposed restriction requirement was restored and the previously-withdrawn claims were again withdrawn. Claims 5, 6, and 19-21 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1, 10, 24, and 25 were rejected under 35 U.S.C. 102(e) as being anticipated by Wu. Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over Wu in view of any one of U.S. Patent No. 2,346,778 to Mitchell (Mitchell '778), U.S. Patent No. 2,373,842 to Mitchell (Mitchell '842), U.S. Patent No. 2,711,461 to Happe (Happe '461) and U.S. Patent No. 3,209,109 to Happe (Happe '109). Claims 5, 6, and 19-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Wu, in view of any one of Mitchell '778, Mitchell '842, Happe '461, and Happe '109, and further in view of U.S. Patent No. 6,653,584 to Chen.

In the present amendment, claim 5 has been amended to delete the wording “at least largely” to address the rejection under Section 112, second paragraph.

Claim 1 has been amended to change “attaching device” to “fastening device”. Claim 1 as amended further defines that at least one element of the fastening device is integrally joined to at least one element of at least said second on-off switch. Support for this feature can be found on page 8, lines 17-30 and in Figs. 5 and 6 of the specification.

The Applicants respectfully submit that the claims as amended are neither anticipated by nor rendered obvious over the cited references, whether viewed alone or in combination.

The primary reference to Wu discloses a hand-held power tool 1 with a barrel grip formed by housing 2 of the hand-held power tool 1 and with a detachable top handle 10 (see Wu, paragraphs [0039] and [0046]; Figs. 1 and 12A). A first switch element 100 is integrated into the barrel grip and a second switch element 12 is integrated into the top handle 10. Each of the switch elements 12, 100 is connected to an electrical switch 103 for activating and deactivating the hand-held power tool 1.

Wu, however, fails to disclose that at least one element of a fastening device 18 for fastening the top handle 10 to the hand-held power tool 1 is integrally joined to at least one element of at least one of the switch elements 12, 100. It is respectfully submitted that Wu is not a proper reference under either MPEP section 2131 or section 2143.03, since the reference does not teach or

suggest every element of the claim. To support a rejection under Section 102, the cited reference must disclose each and every element of the rejected claims with sufficient clarity to prove its existence in the prior art. ***Motorola, Inc., v. Interdigital Tech. Corp.***, 43 USPQ 2d 1481, 1490 (Fed. Cir. 1997).

Further, the rejected claims are not obvious over Wu in combination with the other, secondary references. Wu disclose a fastening device 18 with two protruding portions 184, which are arranged opposite to one another. A lever element 16 of the switch element 12 is arranged between the two protruding portions 184. The end 164 of the lever element 16 is provided to activate the electrical switch 103 (see Wu, paragraphs [0044] to [0048]; Figs. 4, 5, and 12A).

In contrast, the present invention as defined in amended claim 1 integrally joins at least one element 26 of the fastening device 14 to at least one element of at least one second on-off switch 18. The at least one element 26 of the fastening device 14 is built as a locking pin of the fastening device 14, further serving as an actuator rod guide for the second on-off switch 18.

The present invention as defined in amended claim 1, therefore, provides an advantageously compact embodiment of the hand-held power tool. In addition, further components, assembly complexity, space, weight, and costs can be spared (see present application, page 3, lines 15-20).

Wu, in contrast, teaches providing the fastening device 18, the first switch element 100 and the second switch element 12 in a separate manner. Therefore, Wu provides no teaching or suggestion to the practitioner with regard to the present invention as defined in amended claim 1.

Further, none of the secondary documents cited in combination with Wu provide the above features that are lacking from Wu, so that even if the references were combined as proposed, the result would NOT be the present invention.

What the asserted references teach, suggest or motivate is of critical importance in determining whether their teachings can be combined to make a rejection. The law of obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See **KSR International Co. v. Teleflex Inc.**, 82 USPQ2d 1385 (2007) (the Supreme Court specifically retaining the teaching, suggestion, motivation test); and see, e.g., MPEP 2143, inter alia; see also **In re Vaeck**, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (concentrating upon what the prior art actually 'taught', 'expressed', 'conveyed', and/or 'spoke of'). Moreover, merely combining known prior art elements is not sufficient to render the claimed invention obvious if the results would not have been predictable to one of ordinary skill in the art. **KSR International Co. v. Teleflex Inc.**, 82 USPQ2d 1385 (2007); and see, **United States v. Adams**, 383 U.S. 39,42-43, 51-52, 148 USPQ 479, 480, 483-84 (1966) (stating that "[d]espite the fact that each of the elements . . . was well known in the prior art, to combine them as did Adams required that a person reasonably skilled in the prior art must ignore the teaching away of the prior art . . .").

Any attempts at combining the elements of Wu with any of the secondary references, in any combination, fail under these legal analyses.

The application as amended is therefore believed to be in condition for allowance. Action to this end is courteously solicited. However, should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', with a long horizontal flourish extending to the right.

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